

### REMARKS

The Examiner rejected claims 1 and 3 under 35 USC 102(b) as anticipated by the patent to Gianotta, U.S. 2,990,172. The Examiner will note that applicant's claim 3 depends from amended claim 1, which now recites "at least one adjusting plate slidably engaging said base plate" and fitted with at least one plate flange for engaging an electrical box and at least one adjusting handle and a tensioning mechanism engaging the adjusting plate for biasing the plate flange against the electrical box. A close review of the Gianotta patent reveals that this patent includes a base plate for engaging a stud, a pair of adjustable side flanges for engaging the sides of the electrical box and four clips for engaging the top and bottom edges of the electrical box to hold the electrical box in position for nailing to the stud. It is respectfully submitted that there is no recitation, teaching or suggestion in Gianotta of using a plate flange in cooperation with an adjusting plate, a plate handle and a tensioning mechanism as defined in applicant's amended claim 1 and his dependent claim 3.

Reference is made to MPEP Sec.2131, which states that in order for a reference to anticipate a claim, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson vs. Suzuki Motor Co.* 9 USPQ 2<sup>nd</sup> 1913, 1920, (Fed.Cir. 1989). MPEP Sec. 2131 continues, "The elements must be arranged as required by the claim...". *In Re Bond*, 15 USPQ 2<sup>nd</sup> 1566 (Fed.Cir. 1990). It is respectfully submitted that the Gianotta patent fails to show the "identical invention" as that defined in applicants' amended claim 1, as is required for anticipation by the Federal Circuit in *Richardson vs. Suzuki Motor Company*; it is further respectfully submitted that the elements of the Gianotta patent are not arranged as required by applicant's amended claim 1, which is the test for anticipation by the Federal Circuit in *In Re Bond*, since the Gianotta patent fails to include the plate flange and adjusting plate

elements, along with a tensioning mechanism for tensioning the adjusting plate and seating the plate flange against an electrical box. In contrast, the Gianotta patent uses a pair of top and bottom clips, as well as adjustable side flanges for holding the electrical box in a fixed position to facilitate nailing of the box to a stud. Accordingly, it is respectfully submitted that the Gianotta patent fails to anticipate applicant's amended claim 1 and his dependent claim 3 for the reasons outlined above and reconsideration and allowance of applicant's claims 1 and 3 as so amended, is therefore respectfully solicited.

The Examiner also rejected claims 2 and 4 under 35 USC 103(a) as unpatentable over the patent to Gianotta, taken in view of the patent to Wheeler, Sr., U.S. 5,361,509. The Examiner will note that claims 2 and 4 have been cancelled, thereby removing these claims from further consideration in the case.

The Examiner further rejected claims 5, 7, 9 and 11 under 35 USC 103 (a) as unpatentable over the patent to Gianotta, taken in view of the patent to Gehen, Sr., U.S. 5,111,593. The Examiner will note that applicant's claims 5 and 7 have been cancelled and dependent claim 9 amended to depend from applicant's claim 1, which has also been amended as indicated above. Furthermore, applicant's claim 11 is original and depends from claim 9. The Examiner's rejection of applicant's remaining claims 9 and 11 as dependent upon amended claim 1 is therefore respectfully traversed as follows. A close review of the Gehen, Sr. patent shows that this patent is drawn to a template for positioning outlet boxes on a stud, wherein the template has a pair of springs to bias a clamp member in position against a locator box. However, it is significant that neither Gianotta or Gehen, Sr. include a stationary flange in cooperation with a plate flange and a companion adjusting plate slidably carried by a base plate, with a tensioning mechanism to apply pressure to the plate flange and on the electrical box.

MPEP, Sec. 2143 at pp.2100-2122 reads as follows: To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success in doing so. Finally, the prior art (or references when combined) must teach or suggest all of the claimed limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In Re Vaeck*, 20 USPQ 2<sup>nd</sup> 1438 (Fed.Cir. 1991) and *In Re O'Farrell*, 7 USPQ 2<sup>nd</sup> 1673 (Fed.Cir. 1998). It is respectfully submitted that there is no reasonable suggestion or motivation in either the Gianotta or the Gehen, Sr. patents for using applicant's stationary flange/ and sliding adjusting plate and plate flange combination, along with the tensioning mechanism, in the manner set forth in applicant's amended claim 1. Furthermore, to apply the Gehen, Sr. springs to the Gianotta patent would require major modification of the Gianotta device, since there is no logical position or place for the springs to be applied in that device. Indeed, there is no need for springs in Gianotta because Gianotta uses the parallel sets of top and bottom clips to engage the top and bottom edges of the outlet box and to accomplish the purpose of holding the outlet box in a fixed position while nailing the box to a stud. There is therefore, no reason for applying one or more springs to the Gianotta patented device. Accordingly, it is further respectfully submitted that one skilled in the art would have no reason to use the Gehen, Sr. springs in the Gianotta device, because of the radically-different operation of these two devices to achieve the same purpose; that is, to maintain an electrical outlet box in a fixed position on a stud prior to nailing the box to the stud. Furthermore, it is respectfully submitted that there is no reasonable expectation of success

should the Gehen, Sr., springs be used in the Gianotta device, since there is no logical position for these springs to be installed nor is there any reason for using the springs to make the device operable. It is therefore respectfully submitted that one skilled in the art would scarcely reasonably glean from the Gehen, Sr. spring-operated template disclosure and the Gianotta clip-mounted device which uses the side clamps, that springs might work or are even needed in the Gianotta device, without the hindsight teaching of applicant's invention as embodied in the captioned application, including the drawings, specification and amended claims 1, 9 and 11.

This observation leads to the second criteria for establishing a prima facie case of obviousness noted in MPEP Sec. 2143; that the teaching or suggestion to make the claim combination and the reasonable expectation of success must be found in the prior art and not based on applicant's disclosure. As noted above, it is respectfully submitted that the Examiner is applying hindsight in the application of the Gehen, Sr. spring to the Gianotta device, since there is no suggestion, teaching or motivation for doing so in either of these two patent references. There appears to be no reason why one skilled in the art, after reading the Gianotta, Gehen, Sr. patents, would conclude that a spring or springs as applied in the Gehen, Sr. patent could be or would be needed in the Gianotta device. It is clear that the mere fact that references can be combined are modified does not render the result in combination obvious unless the prior art also suggests the desirability of the combination. *In Re Mills*, 16 USPQ 2<sup>nd</sup> 1430 (Fed.Cir. 1990). Federal Circuit case law makes it clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is vigorous application of the requirement for showing of the teaching or motivation to combine prior art references. *C. R. Bard, Inc. M3 Systems, Inc.*, 48 USPQ 2<sup>nd</sup> 1225, 1232 (Fed.Cir.1998). It is respectfully submitted that there is no such motivation or suggestion of any such combination desirability in either Gehen, Sr. or

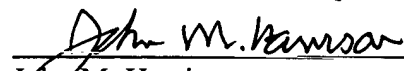
Gianotta. It is therefore respectfully submitted that applicant's claims 1, 9 and 11 as amended, are not made obvious by the Gianotta patent taken in view of the Gehen, Sr. patent and reconsideration and allowance of claims 1, 9 and 11 as so amended, is respectfully solicited.

The Examiner further rejected claims 6, 8, 10 and 12 under 35 USC 103(a) as unpatentable over the Gianotta and Gehen, Sr. patents, taken in view of the patent to Wheeler, Sr., U.S. 5,361,509. The Examiner will note that applicants' claims 6, 8, 10 and 12 have been cancelled, thereby removing the basis for the rejection of these claims.

Claims 13-20 stand allowed.

Every effort has been made to amend applicant's claims in order to define his invention in the scope to which it is entitled. Accordingly, reconsideration and allowance of applicant's remaining claims 1, 3 and 9 as so amended, is respectfully solicited.

Respectfully submitted,

  
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